

JUL 23 2001



## UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE, FOR INTELLECTUAL  
PROPERTY AND DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE  
Washington, D.C. 20231

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MAILED

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Paper No. 28

Office of the Director  
Group 3600

In re Application of  
William P. Newton et al  
Application No. 08/839,161  
Filed: April 22, 1997  
Attorney Docket No.:  
For: SUPPORT SYSTEM FOR LATERALLY  
REMOVABLE SASH

DECISION ON REQUEST  
FOR  
RECONSIDERATION

This is in response to applicants' request for reconsideration filed March 27, 2001. Applicants request reconsideration of the petition decision mailed March 14, 2001 denying applicants' request to withdraw the holding of non-compliance of the appeal brief mailed June 12, 2000.

The Request for Reconsideration is **DENIED**.

Applicants allege that there was a lack of understanding on their part regarding the requirements of 37 CFR 1.192(c)(7). Further, applicants allege that the examiner failed to communicate all possible options or otherwise fully explain the deficiency of the brief in complying with 37 CFR 1.192(c)(7) to enable applicants to appropriately correct the deficiency in a timely manner. In particular, it is applicants' position that had they been able to learn from the examiner that it is permissible for a brief to argue for separate patentability of less than all of the claims on appeal, providing that the claim grouping statement specifically identified only these claims as standing or falling separately, then such a solution would have been readily adopted and a petition of the requirement would not have been made.

With respect to the comments regarding a lack of understanding of the requirements of 37 CFR 1.192(c)(7), it should be noted that, as a registered practitioner, it is presumed that applicants' representative fully understands the requirements of 37 CFR 1.192(c)(7). Moreover, how the Office views the requirements of 37 CFR 1.192(c)(7) has long been well-established by case law. For example, note *Ex parte Schier*, 21 USPQ2d 1016 (BPAI 1991) and *Ex parte Ohsumi*, 21 USPQ2d 1020 (BPAI 1991). Further, applicants should note MPEP § 1206.

With respect to the allegation that the examiner required applicants to either state that the claims stood or fell together or provide a separate argument for every claim, this simply was not the case. In particular, it is noted that in the Office letter mailed July 12, 2000, Paper No. 21, the examiner clearly explained in the second paragraph of page 2 that a separate argument for patentability was required for each claim identified to stand or fall separately. Further, the second paragraph of page 3 clearly indicated that applicants must provide an argument "for each claim **considered** to stand or fall separately" (emphasis added). There is found no statement by the examiner requiring applicants to correct the non-compliance by only one of the two options outlined by applicants in the instant request for reconsideration. At best, it would appear that applicants failed to appreciate what the examiner was stating and this failure led to a misinterpretation that the examiner was requiring one specific course of action rather than merely correction of the non-compliance as a whole.

With respect to the redraft attached to the request for reconsideration, it should be noted that attempts to now overcome the holding of non-compliance are untimely and ineffective. Further, it should be noted that applicants must submit a complete new brief to overcome the holding of non-compliance, not merely the section of the brief that was defective.

While the circumstances outlined by applicants may evidence that the application was abandoned unintentionally or unavoidably, there is no evidence of record that the holding of abandonment was in error. Applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

#### **I. Unavoidable Delay**

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(l); and **(3)** an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the response was unavoidable. This includes a satisfactory showing that the cause of delay resulting in failure to respond in timely fashion to the Office communication was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

## **II. Unintentional Delay**

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(m); and **(3)** a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under the unavoidable standard is \$110 (\$55 for small entity). The fee for a petition under the unintentional standard is \$1240 (\$620 for small entity).

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive.

The required items should be promptly submitted under a cover letter entitled "Petition to Revive".

Further correspondence with respect to a petition to revive should be addressed as follows:

By mail: Deputy Commissioner of Patent Examination Policy  
Box DAC  
Washington, D.C. 20231

By fax: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza 4, Suite 3C23  
2201 South Clarke Place  
Arlington, VA 22202

Telephone inquiries should be directed to the Office of Petitions staff at (703) 305-9282.

SUMMARY: The request for reconsideration is **DENIED**.



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KD/DS; 6/22/01

